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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/998,386

11/15/2001

Joe Nathan Brown

AUS920010875US1

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09/01/2006

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,386

Applicant(s)

BROWN ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12,14-21,23,25-32,34,36-43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12,14-21,23,25-32,34,36-43 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Appeal Brief filed 06/03/2006 to the original application filed 11/15/2001.
2. Claims 1, 3-10, 12, 14-21, 23, 25-32, 34, 36-43, and 45 are currently pending in this application. Claims 2, 11, 13, 22, 24, 33, 35, and 44 have been canceled. Claims 1, 12, 23, 34, and 45 are independent claims.
3. In view of the Appeal Brief filed on 06/03/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection s set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:
 - (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
 - (b) request reinstatement of the appeal.
4. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3-10, 23, and 25-32 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1 and 3-10 are directed to non-statutory subject matter.

Representative claim 1 is reproduced as follows:

“A method of making links that are not easily identified in a displayed Web document by a user to be clearly recognizable comprising the steps of:

- displaying the Web document; and,*
- upon user command, highlighting the links.”*

Claims 1 and 3-10 recite steps for making links and does not transform any physical subject matter, tangible (matter) or intangible (energy) into a different state or thing and, therefore, do not fall within the definition of a statutory “process” or within the meaning of “technology.” The claimed steps can be performed manually by a human. Although a

statutory “process” under § 101 does not have to be performed by a machine, there must be a transformation of physical matter from one state to another, e.g., a step of “mixing” two chemicals transforms two separate chemicals into a manufacture or a composition of matter, regardless of whether it is performed by a human or a machine. Here there is no transformation of physical subject matter. Thus, claims 1 and 3-10 are directed to non-statutory subject matter as not meeting the definition of a “process” under § 101.

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claims is not a tangible result.

Claims 23 and 25-32 are directed to non-statutory subject matter.

Representative claim 23 is reproduced as follows:

“An apparatus for making links that are not easily identified in a displayed Web document clearly recognizable comprising:

- means for displaying the Web document; and*
- means for highlighting the links upon user command.”*

Claims 23 and 25-32 recite “an apparatus” in the preamble only, the body of the claims merely contains software components. Therefore, the claims are software per se and not statutory.

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. In re Lintner, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) (“Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.”) During prosecution, applicant can amend to limit the claims to statutory subject matter.

The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claim 1, 3-10, 12, 14-21, 23, 25-32, 34, 36-43, and 45 are rejected under 35 U.S.C.

102(a) as being anticipated by **DeStefano** (US 6,184,885 - filed 03/16/1998). The DeStefano reference was cited previously.

As to claims 1, 12, 23, and 34:

DeStefano teaches a method, computer program product, apparatus, and computer system (*e.g., a computer system*) of making links (*e.g., links, hyperlinks*) that are not easily identified in a displayed Web document (*e.g., typically selectively enabled in response to a predetermined criteria so that different links may be enabled or disabled under appropriate circumstances*) by a user (*e.g., a user*) to be clearly recognizable [*see the discussion beginning at col.3, line 6*] comprising the steps of:

- *displaying the Web document (e.g., a body of knowledge may be represented in a tag-delimited format such as HTML... Hypertext links and the like may be embedded in the body of knowledge such that a user can navigate to predetermined locations in the same or different lenses specified in the embedded links simply by selecting those links) [see the discussion beginning at col. 18, line 12]; and*
- *upon user command, highlighting the links (e.g., Links are typically selectively enabled in response to a predetermined criteria so that different links may be enabled or disabled under appropriate circumstances) [see col. 3, lines 23-36; see also Fig.7 and the associated text].*

As to claims 3, 14, 25, and 36:

DeStefano teaches having the link flash (*e.g., The highlighting may also take any number of forms... blinking; col. 24, lines 19-28*).

As to claims 4, 15, 26, and 37:

DeStefano teaches displaying the links in a different color (*e.g., The highlighting may also take any number of forms... a display characteristic for highlighted information may be modified, e.g., by modifying ... colors; col. 24, lines 19-28*).

As to claims 5, 16, 27, and 38:

DeStefano teaches displaying the links using a larger font (*e.g., The highlighting may also take any number of forms ... a display characteristic for highlighted information may be modified, e.g., by modifying ... font size; col. 24, lines 19-28*).

As to claims 6, 17, 28, and 39:

DeStefano teaches displaying the links using a different font (*e.g., The highlighting may also take any number of forms ... a display characteristic for highlighted information may be modified, e.g., by modifying font type, font size; col. 24, lines 19-28*).

As to claims 7, 18, 29, and 40:

DeStefano teaches emboldening the links (*e.g., The highlighting may also take any number of forms to visually distinguish highlighted information from unhighlighted*

information ...For example, a display characteristic for highlighted information may be modified, e.g., by modifying font type, font size, font attributes, colors, patterns, shading, and/or blinking; col. 24, lines 19-28).

As to claims 8, 19, 30, and 41:

DeStefano teaches enlarging the font used to display the links including the links target area (*e.g., The highlighting may also take any number of forms to visually distinguish highlighted information from unhighlighted information ...For example, a display characteristic for highlighted information may be modified, e.g., by modifying font type, font size, font attributes; col. 24, lines 19-28).*

As to claims 9, 20, 31, and 42:

DeStefano teaches duplicating the links and displaying duplicated links in a different area (*e.g., (e.g., a separate working copy 54 of the body knowledge is used by page builder 86 for each lens-filter pair during viewing so that appropriate links to different types of information 'especially executable methods' may be maintained; col. 13, lines 42-57).*

As to claims 10, 21, 32, and 43:

DeStefano teaches when a duplicated link is selected, its corresponding link in the web document, among other things, displayed using different font (*e.g., The highlighting may also take any number of forms to visually distinguish highlighted information from unhighlighted information ... by modifying font type, font size; col. 24, lines 19-28).*

As to claim 45:

The rejection of claim 1 above is incorporated herein in full. Additionally, DeStefano teaches:

- asserting an icon in the browser, the icon being able to toggle on to highlight the links and to toggle off to de-highlight the links (*e.g., Each crossover sensitive switch 92 may be toggled on or off to gate whether link pointer highlighting is enabled; col. 19, lines 1-26 & also see Fig. 7 and the associated text*); and
- enlarging the plurality of links and the target areas upon user command to highlighting the plurality of the links (*e.g., The highlighting may also take any number of forms to visually distinguish highlighted information from unhighlighted information ...For example, a display characteristic for highlighted information may be modified, e.g., by modifying font type, font size, font attributes, colors, patterns, shading, and/or blinking; col. 24, lines 19-28*).

Response to Arguments

8. Applicant's arguments filed 12/07/04, 06/02/05 and 06/03/06 have been fully considered but they are not persuasive.

- a. Applicant argues in substance that DeStefano does not teach “*highlighting links that are not easily identifiable in a displayed Web document upon user command*”, as claimed [see the Remarks filed 12/07/2004, page 14; the Remarks filed 06/02/2005, page 12; and the Remarks filed 05/30/2006, page 4].

In response, after further review of the instant claims and the DeStefano reference, a different portion in the DeStefano reference has been found that must be cited as it reads-on the claim limitations. Particularly, DeStefano teaches highlighting links that are not easily identifiable in a displayed Web document upon user command (*e.g., Links are typically selectively enabled in response to a predetermined criteria so that different links may be enabled or disabled under appropriate circumstances*) [see col. 3, lines 23-36; see also Fig.7 and the associated text].

- b. Applicant's arguments filed 05/30/2006 argues that Himmel does not teach “*the step of duplicating links and displaying the duplicated links in a different area*” [see the Remarks filed 05/30/2006, page 5].

In response, the newly cited portion of DeStefano is used to teach duplicating links and displaying the duplicated links in a different area (*e.g., a separate working copy 54 of the body knowledge is used by page builder 86 for each lens-filter pair during viewing so that appropriate links to different types of*

information 'especially executable methods' may be maintained; col. 13, lines 42-57).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bates et al. U.S. Pat. No. 6,222,541 Issued: Apr. 24, 2001
- Bates et al. U.S. Pat. No. 6,323,884 Issued: Nov. 27, 2001
- Bates et al. U.S. Pat. No. 6,751,777 Issued: Jun. 15, 2004
- "Next Button for Jumping/Tabbing between Internet Hypertext Transfer Protocol Hyperlinks", IBM Technical Disclosure Bulletin, 01/1998, pp. 435-436.
- Warren Ernst "Using Netscape" from QUE, March 1995, pp. 322-324.

Contact information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.
- The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN


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